

REMARKS

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the non-final Office Action mailed October 12, 2006.

Applicants respectfully submit that the amendment and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 23 are pending. In particular, Applicants amend claims 1 – 3 and 5 – 23. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

Applicants first wish to express their sincere appreciation for the time that Examiner Carleton and Examiner Koenig spent with Applicants' Attorney, Anthony Bonner, during a telephone discussion on December 6, 2006 regarding the outstanding Office Action. During that conversation, the Examiners indicated that, while the Office Action summary does not indicate whether the drawings are accepted, at this time, the drawings appear to be in condition for acceptance. Additionally, with respect to claim 1, the Examiners seemed to indicate that it would be potentially beneficial for Applicants to make amendments contained herein. Thus, Applicants respectfully request that Examiner Carleton carefully consider this response and the amendments.

II. Claim Objections

The Office Action indicates that claim 2 is objected to because the phrase "the indication" allegedly points out two types of indications described in two separate places. In an effort to comply with the Office Action request, Applicants amend claim 2, as indicated above. Applicants submit that claim 2, as amended, is allowable over the objection.

III. Rejections Under 35 U.S.C. §112

The Office Action indicates that claim 17 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In an effort to comply with the Office Action request, Applicants amend claim 17, as indicated above. Applicants submit that claim 17, as amended, is allowable over the 35 U.S.C. §112 rejection.

In addition, the Office Action indicates that claims 18 – 23 are rejected as allegedly incorporating the deficiencies of claim 17. Applicants submit that the amendments to claim 17 overcome this rejection and that claims 18 – 23, as amended, are allowable over the 35 U.S.C. §112 rejection.

IV. Rejections Under 35 USC §101

Additionally, the Office Action indicates that claims 9 – 15 are rejected under 35 USC §101 because these claims are allegedly directed to non-statutory subject matter. In an effort to comply with the Office Action request, Applicants amend claims 9 – 15, as indicated above. Applicants submit that claims 9 – 15, as amended, are allowable over the 35 U.S.C. §101 rejection.

V. Rejections Under 35 U.S.C. §102

A. Claim 1 is Allowable Over *Lehman*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by article entitled: Wayback machine: , [http://web.archive.org/web/19970125101157; http://www.albion.com/ngmsn/07chat-sample.html](http://web.archive.org/web/19970125101157;http://www.albion.com/ngmsn/07chat-sample.html), (hereinafter "*Lehman*"). Applicants respectfully traverse this rejection on the

grounds that *Lehman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 1 recites:

A method for saving a transcript of instant messaging (IM) chat sessions, the method comprising:
providing an email interface for sending an email message, the email interface including at least one recipient;
receiving an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**;
receiving an indication to save an IM chat transcript of the IM chat session; and
saving the IM chat transcript in response to receiving the indication to save the IM chat transcript. (*emphasis added*)

Applicants respectfully submit that claim 1, as amended, is allowable for at least the reason that the cited art fails to disclose, teach, or suggest a “method for saving a transcript of instant messaging (IM) chat sessions, the method comprising... receiving an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**... [and] **saving the IM chat transcript** in response to receiving the indication to save the IM chat transcript” as recited in claim 1, as amended. More specifically, *Lehman* appears to disclose a “chat room (page 2, line 8)... [configured to] save and print out a transcript of a chat” (page 9, line 24). Applicants respectfully submit that this is different than “receiving an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**... [and] **saving the IM chat transcript** in response to receiving the indication to save the IM chat transcript” as recited in claim 1, as amended. For at least this reason, claim 1, as amended, is allowable over the cited art.

B. Claim 9 is Allowable Over *Lehman*

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Lehman*. Applicants respectfully traverse this rejection on the

grounds that *Lehman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 9 recites:

A tangible computer-readable medium encoded with instructions for execution, comprising:
computer-readable code adapted to instruct a programmable device to provide an email interface for sending an email message, the email interface including at least one recipient;
computer-readable code adapted to instruct a programmable device to receive an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**;
computer-readable code adapted to instruct a programmable device to receive an indication to save an IM chat transcript of the IM chat session; and
computer-readable code adapted to instruct a programmable device to **save the IM chat transcript** in response to receiving the indication to save the IM chat transcript. (*emphasis added*)

Applicants respectfully submit that claim 9, as amended, is allowable for at least the reason that the cited art fails to disclose, teach, or suggest a “tangible computer-readable medium encoded with instructions for execution, comprising... computer-readable code adapted to instruct a programmable device to receive an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**... [and] computer-readable code adapted to instruct a programmable device to **save the IM chat transcript** in response to receiving the indication to save the IM chat transcript” as recited in claim 9, as amended. More specifically, *Lehman* appears to disclose a “chat room (page 2, line 8)... [configured to] save and print out a transcript of a chat” (page 9, line 24). Applicants respectfully submit that this is different than “computer-readable code adapted to instruct a programmable device to receive an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**... [and] computer-readable code adapted to instruct a programmable device to **save the IM chat transcript** in response to receiving the indication to save the IM chat transcript” as recited in claim 9, as amended. For at least this reason, claim 9, as amended, is allowable over the cited art.

C. Claim 16 is Allowable Over *Lehman*

The Office Action indicates that claim 16 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Lehman*. Applicants respectfully traverse this rejection on the grounds that *Lehman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 16 recites:

A system for saving a transcript of instant messaging (IM) chat sessions, the system comprising:

means for providing an email interface for sending an email message, the email interface including at least one recipient;

means for receiving an indication to launch an ***IM chat session*** with at least one recipient of the email message ***from the email interface***;

means for receiving an indication to save an IM chat transcript of the IM chat session; and

means for ***saving the IM chat transcript*** in response to receiving the indication to save the IM chat transcript. (***emphasis added***)

Applicants respectfully submit that claim 16, as amended, is allowable for at least the reason that the cited art fails to disclose, teach, or suggest a “system for saving a transcript of instant messaging (IM) chat sessions, the system comprising... means for receiving an indication to launch an ***IM chat session*** with at least one recipient of the email message ***from the email interface***... [and] means for ***saving the IM chat transcript*** in response to receiving the indication to save the IM chat transcript” as recited in claim 16, as amended. More specifically, *Lehman* appears to disclose a “chat room (page 2, line 8)... [configured to] save and print out a transcript of a chat” (page 9, line 24). Applicants respectfully submit that this is different than “means for receiving an indication to launch an ***IM chat session*** with at least one recipient of the email message ***from the email interface***... [and] means for ***saving the IM chat transcript*** in response to receiving the indication to save the IM chat transcript” as recited in claim 16, as amended. For at least this reason, claim 16, as amended, is allowable over the cited art.

D. Claim 17 is Allowable Over *Lehman*

The Office Action indicates that claim 17 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Lehman*. Applicants respectfully traverse this rejection on the grounds that *Lehman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 17 recites:

A system for saving a transcript of instant messaging (IM) chat sessions, the system comprising:

a provide component configured to provide an email interface for sending an email message, the email interface including at least one recipient;

a first receive component configured to receive an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**;

a second receive component configured to receive an indication to save an IM chat transcript of the IM chat session; and

a save component configured to **save the IM chat transcript** in response to receiving the indication to save the IM chat transcript.
(emphasis added)

Applicants respectfully submit that claim 17, as amended, is allowable for at least the reason that the cited art fails to disclose, teach, or suggest a “system for saving a transcript of instant messaging (IM) chat sessions, the system comprising... a first receive component configured to receive an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**... [and] a save component configured to **save the IM chat transcript** in response to receiving the indication to save the IM chat transcript” as recited in claim 17, as amended. More specifically, *Lehman* appears to disclose a “chat room (page 2, line 8)... [configured to] save and print out a transcript of a chat” (page 9, line 24). Applicants respectfully submit that this is different than “a first receive component configured to receive an indication to launch an **IM chat session** with at least one recipient of the email message **from the email interface**... [and] a save component configured to **save the IM chat transcript** in response to receiving the indication to save the IM chat transcript” as recited in

claim 17, as amended. For at least this reason, claim 17, as amended, is allowable over the cited art.

E. Claims 2, 7, 10, 14, 18, and 22 are Allowable Over *Lehman*

The Office Action indicates that claims 2, 7, 10, 14, 18, and 22 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Lehman*. Applicants respectfully traverse this rejection on the grounds that *Lehman* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claims 2 and 7 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 10 and 14 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 9. Dependent claims 18 and 22 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 17. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

VI. Rejections Under 35 U.S.C. §103

A. Claims 3 – 5, 11 – 12, and 19 – 20 are Allowable Over *Lehman* in view of *Kusuda*

The Office Action indicates that claims 3 – 5, 11 – 12, and 19 – 20 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Lehman* in view of U.S. Publication Number 2003/0088623 (“*Kusuda*”). Applicants respectfully traverse this rejection for at least the reason that *Lehman* in view of *Kusuda* fails to disclose, teach, or suggest all of the elements of claims 3 – 5, 11 – 12, and 19 – 20. More specifically, dependent claims 3 – 5 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 11 – 12 are believed to be allowable for at least the reason that they depend from allowable independent claim 9. Dependent claims 19 – 20 are believed to be allowable for at least the reason that they depend from allowable independent

claim 17. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

B. Claims 6, 8, 13, 15, 21, and 23 are Allowable Over *Lehman* in view of *Kusuda* and further in view of *Gusler*

The Office Action indicates that claims 6, 8, 13, 15, 21, and 23 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Lehman* in view of *Kusuda* and further in view of U.S. Publication Number 2003/0105815 ("*Gusler*"). Applicants respectfully traverse this rejection for at least the reason that *Lehman* in view of *Kusuda* further in view of *Gusler* fails to disclose, teach, or suggest all of the elements of claims 6, 8, 13, 15, 21, and 23. More specifically, dependent claims 6 and 8 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 13 – 15 are believed to be allowable for at least the reason that they depend from allowable independent claim 9. Dependent claims 21 – 23 are believed to be allowable for at least the reason that they depend from allowable independent claim 17. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

VII. Elements of Claims 2, 10, and 18 are Not Inherent

In addition, with respect to claims 2, 10, and 18, the Office Action asserts that *Lehman* "inherently teaches receiving an indication to terminate the IM chat session prior to receiving the indication to save" (OA page 7, line 5). Applicants respectfully traverse the finding of inherency. It is well established that "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may

result from a given set of circumstances is not sufficient." *In Re Anthony J. Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999).

Applicants respectfully submit that the Office Action fails to adequately establish that the subject matter of claims 2, 10, and 18 is necessarily present. As the Office Action fails to provide any extrinsic evidence that makes clear that the missing descriptive matter is necessarily present, Applicants respectfully submit that inherency has not been established. In accordance with *In re Robertson*, Applicants traverse the inherency finding, and submit the claims 2, 10, and 18 are allowable over the cited art.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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